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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,874	02/10/2000	Stephen Lange Ranzini	3892-4000	4487
27123	7590	01/07/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/501,874

Applicant(s)

RANZINI ET AL

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-187 and 189-193 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-187, and 189-193 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This Office action is in response to Applicant's response filed on 9/21/2004.
2. Claims 1-187, and 189-193 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15, 19-27, 55-61, 73-81, 100-112, 121, 122, 126, 128, 129, 130, 140-149, 155-159, 162-164, 172-174, 177-179, 180-182, 189 and 190-193 are rejected under 35 U.S.C. 102 (b) as being unpatentable over Bocinsky (U.S. Pat. No. 5,371,797) in view of Rosen (U.S. Pat. No. 6,047,887).

**As per claims 1, 2, 4, 5, 8-15, 19, 20, 22, 23, 26, 27, 55, 56, 58, 59, 121, 122, 129, 130, 140- 144, 162, 163, 164, 189 and 190-193 Bocinsky substantially discloses a secure electronics funds or other financial transaction system that provides substantially equivalent security to that obtained by the use of secure point of sale terminals which is equivalent to Applicant's claimed invention wherein said: a method for securely transferring electronic funds, comprising;**

a) assigning at least one security attribute to a digital rights management container containing a digital representation of money, wherein the at least one security attribute

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precludes unauthorized access to the container containing the digital representation of money, and wherein the at least one sender-defined security attribute is defined at the time of an electronic fund transfer (see., fig 2, elements 30 and 36, abstract, col 11, lines 3-34, col 12, lines 4-34, please note that Applicant's newly added limitation is disclosed in the abstract, specifically wherein it is stated that conducting a transaction, the customer provides the access code, which is unmasked and concatenated with second portion to recreate the original full encrypted PIN. This, together with the encryption key used for the original encryption is provided to conventional security and transaction processing apparatus for regional banking networks to seek authorization for the transaction, please note that the process of providing the access code, which is unmasked with second portion to recreate the original full encrypted PIN is readable as security attribute that is defined at the time of the fund transfer);

b) transmitting the container containing a digital representation of money to a recipient (see., abstract, lines 6-26, col 6, lines 6-67). Please note that the security attribute is interpreted as the customer security identification such as PIN number that also includes encryption key, password and so, for monitoring or authorizing data passing from a conventional network or for protecting unauthorized access. It is to be noted that Bocinsky fails to explicitly disclose that the security of the electronic funds is without the use of a secure network. However, Rosen discloses a certification agency 28 for providing a process that certifies the validity of a money module for a certain period of time by issuing a certificate instead of a secure network (see., abstract, col 5, lines 12-22, col 14, lines 3-43, col 6, lines 31-54, col 7, lines 30-65). It would have been obvious

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to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Bocinsky by including the limitation detailed above as taught by Rosen because this would determine the validity of an electronic fund transfer based on a user PIN or ID or password.

**As per claims 3, 21 and 57, Bocinsky** discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money enter password, social security number, employee identification number or personal identification number (see., col 4, lines 36-59).

**As per claims 6, 24 and 60, Bocinsky** discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing digital representation of money prove they are the intended recipient through use of a random number generator card or smart card (see., col 5, lines 23-39).

**As per claims 7, 25 and 61, Bocinsky** discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money prove they are the intended recipient through biometric scan comprised of a retina scan, fingerprint, voiceprint (see., col 18, lines 48-68).

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Claims 73-81, 126, 145-149, 172, 173 and 174 are system claims that contain the same limitation as claims 1-18, and claim 73, therefore are rejected by the same rationale.

Claim 100-108, 128, 155-159, 177, 178 and 179 are system claims that contain the same limitation as claims 1-18, therefore are rejected by the same rationale.

Claims 109-112, 180, 181 and 182, contains the same limitation as claim 1, therefore are rejected by the same rationale.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 62- 72, 113-120, 125, 170, 171 and 183-187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797) and Rosen.

**As per claims 62-72, 113-120, 125, 170, 171, 183, 184, 185, 186 and 187 Bocinsky** and Rosen substantially disclose the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official

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Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bocinsky and Rosen by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797) and Rosen .

**As per claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176, Bocinsky and Rosen** substantially disclose the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at

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the time the invention was made to modify the teachings of Bocinsky and Rosen by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

### **RESPONSE TO ARGUMENTS**

9. Applicant's arguments filed on 9/21/2004 have been fully considered but they are not persuasive.

### **REMARKS**

10. In response to Applicant's arguments, Applicant argues that the prior art of record taken alone or in combination fail to anticipate or render obvious the recited feature:

a. " to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it



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may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " definition does not occur at the time of a fund transfer". However, the Examiner respectfully disagrees with this assertion since Bocinsky in the abstract, col 11, lines 3-34, col 12, lines 4-34, specifically wherein said conducting a transaction, the customer provides the access code, which is unmasked and concatenated with second portion to recreate the original full encrypted PIN. This, together with the encryption key

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used for the original encryption is provided to conventional security and transaction processing apparatus for regional banking networks to seek authorization for the transaction, please note that the process of providing the access code, which is unmasked with second portion to recreate the original full encrypted PIN is readable as security attribute that is defined at the time of the fund transfer).

c. "the encryption PIN does not constitute a definition". As indicated above, it is believed that Bocinsky discloses this limitation in the abstract, col 11, lines 3-34, col 12, lines 4-34. Please note the original full encrypted PIN is readable as security attribute that is defined at the time of the electronic funds transfer.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

January 03, 2005